

Remarks

Claims 1 to 20 are presently pending in this patent application. In view of the following remarks, reconsideration and withdrawal of the requirement for restriction ("Requirement") which is the subject of the Action are requested respectfully.

Discussion of the Requirement and Provisional Election

The Action requires applicants to select one of the following three groups of allegedly patentably distinct inventions for examination.

- I. Claims 1 to 18, drawn to a compound of formula (I) and a pharmaceutical composition containing a compound of formula (I);

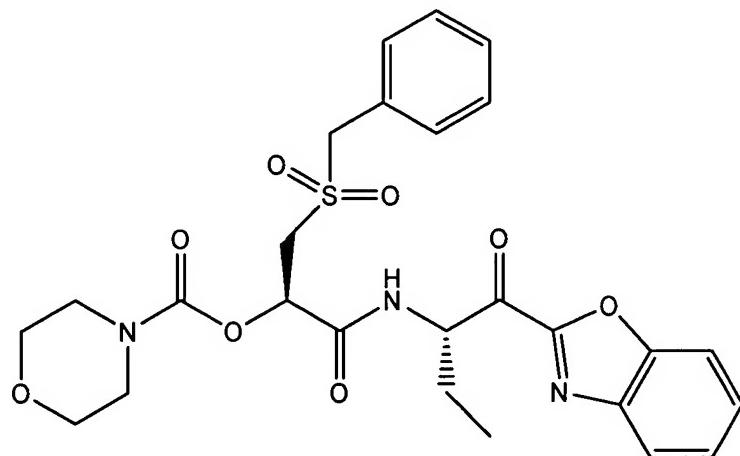
- II. Claim 19, drawn to a method of treating a disease with a compound of formula (I);
and

- III. Claim 20, drawn to a process for the preparation of a medicament comprising a compound of formula (I).

Although applicants submit respectfully that the Requirement is improper, applicants elect provisionally the claims of Group I. Because the elected Group I claims are directed to a compound and a composition and the non-elected Group II claim is directed to a method of using such a compound, applicants request that, if the claims of elected Group I are allowed, the claim of non-elected Group II be rejoined in accordance with MPEP § 821.04. Further, applicants reserve the right to pursue any subject matter that remains after the prosecution of the present in a

future continuing patent application such as, for example, a division.

The Action includes also a request that applicants elect a species of the compounds represented by formula (I). In this regard, applicants elect as the species the compound morpholine-4-carboxylic acid (R)-1-[(S)-1-(1-benzoazol-2-yl-methanoyl)-propylcarbamoyl]-2-phenylmethanesulfonyl-ethyl ester that is described in Example 4 at page 97 of the specification and the structure of which is set forth below.



Request for Reconsideration of the Requirement

Applicants request respectfully reconsideration of the Requirement, or in the alternative, modification of the Requirement to allow prosecution of more than one group of claims designated by the Examiner.

MPEP § 803 states clearly that restriction is *not required* unless the inventions are independent or distinct *and* there would be a serious burden on the Examiner if restriction is not required. Accordingly, "[i]f the Search and Examination of all the claims in an Application can be made without serious burden, the Examiner *must* examine them on the merits, even though they include claims to independent or distinct inventions". MPEP § 803 (emphasis added). A serious burden on the Examiner exists where the claimed inventions are (1) separately classified; (2) have a separate status in the art when they are classifiable together; or (3) have a different field of search. See MPEP § 808.02.

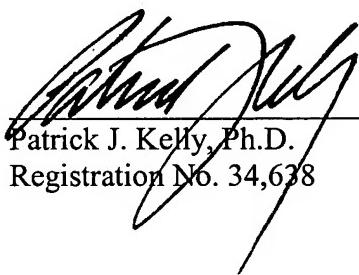
Applicants submit respectfully that a serious burden on the Examiner has not been established as the claims of Groups I to III are not separately classified, do not have a separate status in the art and have the same field of search. For example, the Examiner has classified the claims of Group I (Claims 1 to 18, a compound of formula (I) and a pharmaceutical composition containing a compound of formula (I)) in classes **514, 544, 546, 548** and **549**. The Examiner has classified also the subject matter of the claim of Group II (Claim 19, a method of treating a disease with a compound of formula (I)) in class **514**; and has classified the subject matter of the claim of Group III (Claim 20, a process for the preparation of a medicament comprising a compound of formula (I)) in classes **514, 544, 546, 548** and **549**. Thus, the claims of Groups I to III are classified in the same classes and have the same field of search. In addition, the Action provides no evidence that the claims of Groups I to III have a separate status in the art when they are classified together. Thus, applicants submit respectfully that a search and examination of all of the claims should be made because the facts show clearly that it would *not* be a serious burden for the Examiner to examine all of the claims of Groups I to III. Accordingly, reconsideration and withdrawal of the Requirement are requested respectfully.

Conclusion

In the event any matters remain outstanding, the Examiner is requested to call the undersigned at the telephone number listed below.

The Commissioner is authorized hereby to charge any fees or credit any overpayment associated with this Reply (copy enclosed) to Deposit Account Number 19-5425.

Respectfully submitted,
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